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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,326	12/20/1999	Reiner Delp	MERCK 2038	2158

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EXAMINER

NGUYEN, KIMBERLY T

ART UNIT	PAPER NUMBER
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1774

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DATE MAILED: 02/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-9

Office Action Summary

Application No.

09/446,326

Applicant(s)

DELP ET AL.

Examiner

Kimberly T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2001 and 14 December 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

This action is in response to the amendments submitted on November 5, 2001 and December 14, 2001.

Specification

Due to Applicants' remarks, the objections to the abbreviations PS, PBT, and PET are withdrawn.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Due to Applicants' remarks and amendments, the rejections of claims 1-12 based on 35 USC 112 and 35 USC 101 are withdrawn.

Claim Rejections - 35 USC § 103

Claims 1-12 are rejected under 35 U.S.C 103(a) as being unpatentable over WO 95/30716 in view of EP 0 367 629 for the reasons set forth in the previous Office Action, mailed on May 3, 2001.

Claims 1 and 13-21 are rejected under 35 U.S.C 103(a) as being unpatentable over WO 95/30716 (WO) in view of EP 0 367 629 (EP).

WO 95/30716 is relied upon as above. WO shows that the plastics used to make moulds contain from .05 to 10% of absorber material that can be laser-marked. WO shows that the polymer particles have a diameter of 1- 100µm (page 25, lines 1-25). WO shows light-sensitive

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pigments of SiO₂ (page 21, lines 1-8). WO shows that the plastic is polyester (page 2, line 33 to page 6, line 17).

Though WO shows polyamides and polyarylene ethersulphone as an absorber material, WO does not show the absorber materials as shown in instant claim 15. EP shows absorber materials such as polyimide and polyphenylene-sulphide (page 2, lines 23-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the absorber material of the instant invention--polyphenylene-sulphide--since it is a functional equivalent of the polyimide absorber materials.

Though WO shows that polyarylene ketones can be used as the particles (Abstract), WO does not specifically show that the particles have a melting point of greater than 300 degrees Celsius as in instant claim 18. EP shows that polyetherketones, such as PEEK, can be used as a particle. PEEK is known to have a melting point of 343 degrees Celsius. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a particle with the melting point of claim 18 since a high-temperature resistant plastic is needed to withstand laser marking.

WO does not specifically show that the particles have an irregular shape as in instant claim 21. However, the shape or configuration of an invention is a matter of choice to a person of ordinary skill in the art who would find it obvious absent persuasive evidence that the particular configuration of the claimed invention is significant. Further, the various shapes of an invention are optimizable.

Response to Arguments

Applicant's arguments filed on November 5, 2001 (Amend.) and December 14, 2001 (Supp. Amend.) have been fully considered but they are not persuasive.

On page 3 of the Amend., Applicants argue that the Office Action fails to provide any rational or evidence to combine the WO and EP references because WO does not show the desirability of using the color pigments of EP. Examiner disagrees. WO does show color pigments (page 20 to page 21, line 8). In addition, the term "pigment" means a coloring substance.

On pages 5-6 of the Supp. Amend., Applicants argue that WO and EP fail to show micromilled particles since the particles in these references do not have an irregular shape, as stated in the Declaration provided. The examiner finds the Declaration unpersuasive. The Declaration merely states that WO and EP do not show micromilled particles. Furthermore, the Declaration does not show how micromilled particles or irregularly shaped particles affect how the invention can be more effectively laser-marked. Lastly, the Declaration does not show how a rough versus smooth surface of absorber particles changes laser-markable plastics.

Conclusion

APPLICANT'S AMENDMENT necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Nguyen whose telephone number is (703) 308-8176.

The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for before final communications and (703) 872-9311 for after final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

A handwritten signature in black ink, appearing to read 'Cynthia H. Kelly', is written over the printed name and title.